

Attorney Docket No.: WD2-98-109

2761 GP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Jay S. Walker et al.

For: METHOD AND APPARATUS FOR
FACILITATING ELECTRONIC
COMMERCE THROUGH PROVIDING
CROSS-BENEFITS DURING A
TRANSACTION

Serial No.: 09/219,267

Filing Date: December 23, 1998

Assistant Commissioner for Patents
Washington, D.C. 20231



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MAY 25 1999

Group 2700

Examiner: Not Yet Assigned

Group Art Unit: 2761

Docket No.: WD2-98-109

#5
A. Colton
7-26 99

TRANSMITTAL LETTER

Sir:

Applicants hereby submit the following documents for the above-identified patent application:

1. Information Disclosure Statement;
2. Form PTO-1449;
3. Copy of seventeen (77) references cited therein; and
4. Postcard.

The Commissioner is hereby authorized to charge \$ 0.00 to Deposit Account No. 50-0271 for the fees required for the enclosed Information Disclosure Statement. The Commissioner is further authorized to charge any further required fees, or to credit any overpayment, to Deposit Account No. 50-0271. A duplicate copy of this authorization is attached for such purpose.

Respectfully submitted,



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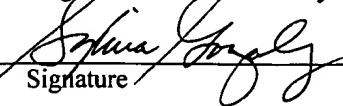
May 7, 1999
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I hereby certify that this correspondence is being sent via first class mail in an envelope with sufficient postage addressed to Assistant Commissioner for Patents, Washington, D.C. 20231 on May , 1999.

Sylvia Gonzalez

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Signature

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Date



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Washington, D.C. 20231

INFORMATION DISCLOSURE STATEMENT

Sir:

Applicants submit herewith patents, publications or other information of which they are aware that they believe may be material to the examination of this application, and in respect of which, there may be a duty to disclose.

The filing of this information disclosure statement shall not be construed as a representation that a thorough search has been made, an admission that the information cited is, or is considered to be, material to patentability, or that no other material information exists. Nor shall the filing of this information disclosure statement be construed as an admission against interest in any manner.

This Information Disclosure Statement is filed in accordance with 37 C.F.R. §§1.56, 1.97 and 1.98. The items listed below and on the accompanying Form PTO-1449 may be deemed to be pertinent to the above-identified application and are made of record to assist the Patent and Trademark Office in its examination of this application. The Examiner is respectfully requested to fully consider these items and to independently ascertain their teaching.

A. U.S. Patent No. 4,491,725 entitled "MEDICAL INSURANCE VERIFICATION AND PROCESSING SYSTEM" issued to Lawrence E. Pritchard on January 1, 1985.

B. U.S. Patent No. 4,667,292 entitled "MEDICAL REIMBURSEMENT COMPUTER SYSTEM" issued to William C. Mohlenbrock et al. on May 19, 1997. **RECEIVED**

C. U.S. Patent No. 4,750,119 entitled "PURCHASING SYSTEM WITH ~~RE~~ DATE 25 1999 FEATURE" issued to Jeffery M. Cohen et al. on June 7, 1988. **Group 2700**

D. U.S. Patent No. 4,982,346 entitled "MALL PROMOTION NETWORK APPARATUS AND METHOD" issued to Kenneth P. Giroud et al. on January 1, 1991.

E. U.S. Patent No. RE.34,380 entitled "METHOD AND APPARATUS FOR APPLYING MESSAGES IN A TELECOMMUNICATIONS NETWORK" issued to Neil F. Sleevi on September 14, 1993.

F. U.S. Patent No. 5,287,268 entitled "CENTRALIZED CONSUMER CASH VALUE ACCUMULATION SYSTEM FOR MULTIPLE MERCHANTS" issued to Patrick D. McCarthy on February 15, 1994.

G. U.S. Patent No. 5,319,542 entitled "SYSTEM FOR ORDERING ITEMS USING AN ELECTRIC CATALOGUE" issued to John E. King, Jr., et al. on June 7, 1994.

H. U.S. Patent No. 5,333,186 entitled "TELECOMMUNICATION CALL BILLING METHOD AND APPARATUS" issued to Shiv K. Gupta on July 26, 1994.

I. U.S. Patent No. 5,523,794 entitled "METHOD AND APPARATUS FOR PORTABLE STORAGE AND USE OF DATA TRANSMITTED BY TELEVISION SIGNAL" issued to Roy J. Mankovitz on June 4, 1996.

J. U.S. Patent No. 5,612,868 entitled "METHOD AND APPARATUS FOR DISPENSING DISCOUNT COUPONS" issued to George W. Off et al. on March 18, 1997.

K. U.S. Patent No. 5,619,558 entitled "ATM SEGMENT OF ONE MARKETING METHOD" issued to Elizabeth A. Jheeta on April 8, 1997.

- L. EP 809202 Patent entitled "METHOD AND SYSTEM FOR REGULATING DISCOUNTS ON MERCHANDISE DISTRIBUTED THROUGH NETWORKED COMPUTER SYSTEMS" issued to Jakob Nielson on November 26, 1997.
- M. WO 98/06050 Patent entitled "SYSTEM AND METHOD FOR TARGETED PAYMENT SYSTEM DISCOUNT PROGRAM" issued to Roger L. Pierce et al. on February 12, 1998.
- N. Pagoda, Dianne M., "G.E.C.C. OFFERS CREDIT CARD WITH DISCOUNTS, REBATES, GENERAL ELECTRIC CAPITAL CORP.", WWD (Women's Wear Daily) September 3, 1992.
- O. "Chemical Bank and AT&T Smart Cards form strategic alliance", (<http://www.att.com/press/1193/931117.blb.html>), November 17, 1993.
- P. U.S. Patent No. 5,652,784 entitled "AUTOMATIC TELEPHONE ADVERTISING PROVIDED IN LIEU OF DIAL-TONE" issued to Georgina Borbon Blen et al. on July 29, 1997.
- Q. U.S. Patent No. 5,694,551 entitled "COMPUTER INTEGRATION NETWORK FOR CHANNELING CUSTOMER ORDERS THROUGH A CENTRALIZED COMPUTER TO VARIOUS SUPPLIERS" issued to John D. Doyle et al. on December 2, 1997.
- R. U.S. Patent No. 5,717,866 entitled "METHOD FOR COMPARATIVE ANALYSIS OF CONSUMER RESPONSE TO PRODUCT PROMOTIONS" issued to Walter L. Naftzger on February 10, 1998.
- S. U.S. Patent No. 5,724,521 entitled "METHOD AND APPARATUS FOR PROVIDING ELECTRONIC ADVERTISEMENTS TO END USERS IN A CONSUMER BEST-FIT PRICING MANNER" issued to Rick Dedrick on March 3, 1998.
- T. U.S. Patent No. 5,752,238 entitled "CONSUMER-DRIVEN ELECTRONIC INFORMATION PRICING MECHANISM" issued to Rick Dedrick on May 12, 1998.

- U. U.S. Patent No. 5,761,648 entitled "INTERACTIVE MARKETING NETWORK AND PROCESS USING ELECTRONIC CERTIFICATES" issued to Steven M. Golden on June 2, 1998.
- V. U.S. Patent No. 5,774,869 entitled "METHOD FOR PROVIDING SPONSOR PAID INTERNET ACCESS AND SIMULTANEOUS SPONSOR PROMOTION" issued to Adrian Toader on June 30, 1998.
- W. U.S. Patent No. 5,794,221 entitled "INTERNET BILLING METHOD" issued to Andrew Egendorf on August 11, 1998.
- X. U.S. Patent No. 5,794,210 entitled "ATTENTION BROKERAGE" issued to August 11, 1998.
- Y. U.S. Patent No. 5,806,044 entitled "SYSTEM AND METHOD FOR DISTRIBUTING COUPONS THROUGH A SYSTEM OF COMPUTER NETWORKS" issued to Ken R. Powell on September 8, 1998.
- Z. U.S. Patent No. 5,806,045 entitled "METHOD AND SYSTEM FOR ALLOCATING AND REDEEMING INCENTIVE CREDITS BETWEEN A PORTABLE DEVICE AND A BASE DEVICE" issued to James E. Biorge et al. on September 8, 1998.
- AA. Kristof, Kathy "CARD SHARKS ARE IN SEASON; BE WARY OF DISCOUNTS AND REBATES AS YOU SHOP AROUND FOR GOOD CREDIT DEALS", Chicago Tribune November 23, 1993.
- BB. Rosenberg, Joyce M. "GE CAPITAL COMES TO MACY'S AID AGAIN", AP Worldstream February 17, 1994.
- CC. U.S. Patent No. 5,819,092 entitled "ONLINE SERVICE DEVELOPMENT TOOL WITH FEE SETTING CAPABILITIES" issued to Charles H. Ferguson et al. on October 6, 1998.
- DD. U.S. Patent No. 5,826,244 entitled "METHOD AND SYSTEM FOR PROVIDING A DOCUMENT SERVICE OVER A COMPUTER NETWORK USING AN AUTOMATED BROKERAGE AUCTION" issued to Bernardo A. Huberman on October 20, 1998.
- EE. U.S. Patent No 5,845,265 entitled "CONSIGNMENT NODES" issued to Thomas G. Wollston on December 1, 1998.

- FF. Block, Valerie "GM Turns up the heat with plan to cross-sell some financial products", The American Banker, November 18, 1994.
- GG. Ellis, Stephen, "Credit Card firms drive down costs", Sunday Times February 27, 1994.
- HH. "PAGERS THAT CAN SPELL IT ALL OUT", Business Week January 16, 1995.
- II. Meece, Mickey "BIG FINANCE COMPANIES MAY WANT PIECE OF LIMITED'S PRIVATE-LABEL CARD PROGRAM", The American Banker April 12, 1995.
- JJ. Schrage, Michael "FREE STUFF! PREDATORY PRICING OR CREATIVE CROSS-PROMOTION? YOU BE THE JUDGE; THE BETA VERSION; INDUSTRY TREND OR EVENT" Marketing Computers, October 1995.
- KK. Marshall, Kyle "MORE PHONE CHOICES RING IN", The News and Observer, August 13, 1996.
- LL. Wessel, Harry "REWARDING EXPERIENCE?; CREDIT CARDS OFFERING BONUSES NOT FOR EVERYONE", Chicago Tribune, November 4, 1996.
- MM. Selasky, Susan "EASY-TO-SWALLOW SAVINGS; DINER CREDIT CARDS SERVE WIDE MENU OF DISCOUNTS"" Pittsburgh Post-Gazette December 5, 1996.
- NN. "MERGER CREATED ALLIANCE DATA", Credit Risk Management Report, December 16, 1996.
- OO. Higgins, Stephen "DIGITAL PHONE SERVICE ON THE WAY" Business Dateline; New Haven Register, January 7, 1997.
- PP. Kerstetter, Jim "E-COMMERCE UPDATES GET INTELLIGENT AGENTS; ELECTRONIC COMMERCE", PC Week, February 3, 1997.
- QQ. Barlow, Rick "RELATIONSHIP MARKETING: COALITION MARKETING IS COMING BACK", Brandweek April 28, 1997.
- RR. Simon, Ruth "MAKE SURE YOUR REBATE CARD STILL DELIVERS THE GOODS", Money August 1997.
- SS. Gilligan, Gregory J. "CREDIT CARDS FROM RETAIL STORES A MIXED BLESSING FOR SHOPPERS", The Richmond Times Dispatch, July 20, 1997.

- TT. Fitzgerald, Beth "NEW JERSEY-BASED SCA HELPS PRIVATE LABEL CREDIT CARDS TAKE OFF", The Star Ledger, August 4, 1997.
- UU. Sanders, Edmund "TRICKY BUSINESS; THE MAGIC OF REBATE CARDS CAN QUICKLY DISAPPEAR", Chicago Tribune August 18, 1997.
- VV. Wijnen, Renee "CENDANT EYES CROSS-MARKETING OPPORTUNITIES; CUC INTENRATIONAL-HFS INC. MERGER EXPECTED TO YIELD AN ADDITIONAL 2 MILLION CLUB MEMBERS" DM News , February 2, 1998.
- WW. "CARDHOLDERS THINK BIG" Bank Marketing International , March 1998.
- XX. Wald, Matthew L. "SPENDING IT; UTYING CELLULAR PHONES FROM THOSE ANNUAL CONTRACTS" THE NEW YORK TIMES, March 15, 1998.
- YY. "AMERICAN EAGLE OUTFITTERS, INC. INTRODUCES THE FIRST CLEAR CREDIT CARD" PR Newswire , March 26, 1998.
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- AAA. "CARD BRIEFS: BENEFICIAL, CASUAL MALE TEAM UP ON CARD" The American Banker May 4, 1998.
- BBB. "POINTS EARN LITTLE CREDIT AS CARDHOLDERS FAIL TO CASH IN" Birmingham Post , May 9, 1998.
- CCC. "JAY JACOBS INC. INTRODUCES PRIVATE LABEL CREDIT CARD", Business Wire May 18, 1998.
- DDD. "WELLSPARK GROUP LAUNCHES V.I.P. REWARDS; THE MOST COMPREHENSIVE REALATIONSHIP MARKETING PROGRAM EVER CREATED BY A MALL DEVELOPER", Business Wire , May 19, 1998.
- EEE. "SNET CELLULAR VALUE PLANS", Brochure, June 12, 1998.
- FFF. "SHOPPERS CHARGE ACCOUNTS CO. TO ADMINISTER PRIVATE LABEL CREDIT CARD FOR LEW MAGRAM LTD.; PROGRAM MARKS SCA'S ENTRY INTO RETAIL CATALOG/MAIL ORDER INDUSTRY" PR Newswire, June 29, 1998.
- GGG. "CELL PHONES AT 7-11? ALMOST EVERYONE IS SELLING WIRELESS SERVICE THESE DAYS. HERE'S HOW TO GET THE RIGHT DEAL" Time Magazine, July 6, 1998.

HHH. "THE SAVINGS GAME; READ FINE PRINT IN REBATE OFFERS BY CREDIT CARDS", The Cincinnati Enquirer, August 31, 1998.

III. "WAL-MART ON RETAIL ROAD LESS TRAVELED: COBRANDING" The American Banker, September 11, 1998.

JJJ. Elkin, Tobi "PROMTIONS: MASTERCARD WINS COVETED ON-PACKREAL ESTATE IN TIE-IN WITH MICROSOFT" Brandweek, September 14, 1998.

KKK. "CLUBMACY'S" brochure, September 1998.

LLL. "FILENE'S Credit Card Application, September 1998.

MMM. "DUAL-FUNCTION CARDS LATEST PITCH TO CALL IN HOLDERS", Card Marketing, November 1998.

NNN. ISSUERS CHARGE AHEAD TO FOCUS ON PRICE VS. BRAND", Card Marketing, November 1998.

OOO. "COMPETITION: FIRST USA, WITH ITS MICROSOFT PACT, IS KING OF THE INTERNET", Credit Card News, November 1, 1998.

PPP. "RETAIL CARDS" ATTENTION KMART CARD HOLDERS: 6% BACK IS DEAD A NEW PACKAGE OF PERKS IS COMING" Credit Card News November 1, 1998.

QQQ. "MICROSOFT AND FIRST USA ANNOUNCES \$90 MILLION ONLINE ADVERTISING ALLIANCE""EDP Weekly" IT Monitor, November 2, 1998.

RRR. Feldman, Amy "PAYING WITH PLASTIC NOT SUCH A SMART IDEA", New York Daily News, November 4, 1998.

SSS. Cowell, Alan "AMERICA'S TURN TO COLONIZE; CREDITCARD ISSUERS INVADE BRITAIN, WITH U.S. FIREPOWER", The New York Times, November 12, 1998.

TTT. "TO BUSINESS AND TECHNOLOGY EDITORS", PR Newswire, November 27, 1998.

UUU. Shermach, Kelly "PARTNERSHIPS HELP ISSUERS WEAVE WEB CONCEPTS", Card Marketing, December 1998.

VVV. "LARGEST INTERNET AD DEAL SIGNED", Bank Marketing International, December 1998.

WWW. "AMAZON.COM AND NETFLIX.COM ESTABLISH PROMOTIONAL RELATIONSHIP FOR THE SALE AND RENTAL OF DVD TITLES" Business Wire, December 4, 1998.

XXX. "AT SPORTS SUPERSTORE ONLINE, SHOPPERS GET MORE FOR THEIR MONEY; 10,000 REASONS TO SHOP AT SPORTS SUPERSTORE ONLINE", Business Wire, December 4, 1998.

YYY. "CREDIT CARD ENTICEMENTS", NPR MORNING EDITION, December 23, 1998.

1. [] Any copy of the items listed above and on the enclosed copy of Form PTO-1449 that is not enclosed with this Information Disclosure Statement was previously cited by or submitted to the Patent and Trademark Office in the prior [] Continuation, [] Divisional or [] Continuation in part application filed under 37 C.F.R. §§ 1.53 or 1.60, U.S. Serial No. _____, filed _____.
2. [] For each of the following items listed above and on the enclosed copy of Form PTO-1449 that is not in the English language, a European Search Report from a counterpart European application is enclosed. Such items are marked as reference letter(s): _____.
3. [] For each of the following items listed above and on the enclosed copy of Form PTO-1449 that is not in the English language, a concise explanation of the relevance of that item is incorporated in the specification of the above-identified application. Such items are marked as reference letter(s): _____.
4. [x] In addition to the citations listed above, applicants respectfully direct the Examiner's attention to the following U.S. patent applications, which are commonly assigned to the assignee of the instant application, and which may be deemed pertinent to the instant application:

Serial No.	Inventors	Filing Date	Group Art Unit	Examiner's Init.
08/943,483	Walker et al.	10/03/97	3642	
08/994,426	Walker et al.	12/19/97	2761	
09/100,684	Tedesco et al.	06/19/98	2761	
09/166,367	Walker et al.	10/05/98	2761	
09/166,405	Walker et al.	10/05/98	2761	
09/205,663	Walker et al.	12/04/98	2761	

The Examiner is respectfully requested to fully consider and independently ascertain the teachings and relevance of those applications with respect to the instant application. These applications have not been listed on the accompanying Form PTO-1449 in order to preserve their secrecy during the course of their prosecution.

5. [] No fee is believed to be due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with:

- [] 37 C.F.R. §1.97(b)(2), within three months of the date of entry into the national stage as set forth in §1.491.
- [x] 37 C.F.R. §1.97(b)(3), before the mailing date of a first Office Action on the merits.

6. [] No fee is believed to be due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. 1.97(c), after the period specified in paragraph 5 above but before the mailing date of a final action or a Notice of Allowance (where there has been no prior final action), and is accompanied by one of the certifications pursuant to 37 C.F.R. §1.97(e) set forth in paragraph 10 below.

7. [] A fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. §1.97(c) after the period specified in paragraph 5 above but before the mailing date of a final action or a Notice of Allowance (where there has been no prior final action). The fee due under 37 C.F.R. §1.17(p) is to be paid as set forth in paragraph 11 below.

8. [] A fee is due under 37 C.F.R. §1.17(i)(1) for this Information Disclosure Statement since it is being filed in accordance with 37 C.F.R. §1.97(d), after the mailing date of a final action or a Notice of Allowance, but before the payment of the issue fee, and is accompanied by:

- a. one of the certifications pursuant to 37 C.F.R. §1.97(e) set forth in paragraph 10 below; and
- b. the attached petition requesting consideration of this Information Disclosure Statement; and
- c. the fee due under 37 C.F.R. §1.17(i)(1) which is paid as set forth in paragraph 11 below.

9. [] A fee is due under 37 C.F.R. §1.17(i)(1) for this Information Disclosure Statement since it is being filed in compliance with:

- [] 37 C.F.R. §1.313(b)(3), after the issue fee has been paid and information cited in this Information Disclosure Statement may render at least one claim unpatentable and is accompanied by the attached Petition to Withdraw Application from Issue;
- [] 37 C.F.R. §1.313(b)(5), after the issue fee has been paid and information cited in this Information Disclosure Statement is to be considered in a Continuation application upon abandonment of the instant application and

is accompanied by the attached Petition to Withdraw Application from Issue.

[] The fee due under 37 C.F.R. §1.17(i)(1) is paid as set forth in paragraph 11 below.

10. [] I hereby certify:

[] that each item of information contained in the Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. A copy of such communication is enclosed.

[] that no item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to my knowledge after making reasonable inquiry, was known to any individual designated in §1.56(c) more than three months prior to the filing of this Information Disclosure Statement.

11. [] Please accept payment of the fees due as indicated below:

[] A check in the amount of \$240.00 is enclosed in payment of the fee due under 37 C.F.R. 1.17(p).

[] The Commissioner is hereby authorized to charge \$240.00 to Deposit Account No. 50-0271 in payment of the fee due under 37 C.F.R. §1.17(p). A duplicate copy of this sheet is attached for such purpose

[] A check in the amount of \$130.00 is enclosed in payment of the fee due under 37 C.F.R. §1.17(i)(1).

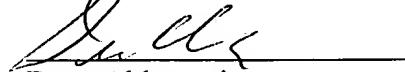
[] The Commissioner is authorized to charge \$130.00 to Deposit Account No. 50-0271 in payment of the fee due under 37 C.F.R. §1.17(i)(1). A duplicate copy of this sheet is attached.

12. [X] The Commissioner is hereby authorized to charge any additional fees which may be required for this Information Disclosure Statement, or credit any overpayment to Deposit Account No. 50-0271. A copy of this authorization is attached.

May 17, 1999

Date

Respectfully submitted,



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